

## **REMARKS**

Entry of the amendments is respectfully requested. Claims 1, 9, 10, and 31 have been amended. Claims 1-23 and 25-31 are pending in the application. Favorable reconsideration and allowance of this application is respectfully requested in light of the foregoing amendments and the remarks that follow.

### **1. Rejections Based on the Prior Art**

#### **a. Recapitulation of the Invention<sup>1</sup>**

The invention relates to a lightweight, easy to assemble, and compact exciter assembly for a compaction device such as a drum assembly of a vibratory trench roller or another vibratory compactor. The exciter assembly includes a fixed weight and one or more free swinging weights that can be mounted on an exciter shaft, without using any mounting hardware, so as to hold the free swinging weights axially in position while permitting them to swing between first and second angular positions on the exciter shaft. Preferably, the fixed weight is mounted on a central portion of the exciter shaft, and two free swinging weights are mounted adjacent the ends of the fixed weight so as to be restrained from substantial sliding movement along the exciter shaft solely by the fixed weight and other operative components of the exciter assembly, such as bearings and/or gears or other torque transfer elements. The lack of need for mounting hardware considerably simplifies assembly. The reduction in length afforded by this design

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<sup>1</sup> This Section 1a is intended to provide the Examiner with some background information on the state of the art applicants' contribution to it. It is *not* intended to distinguish specific claim for the prior art. That task is performed in Section 1b below.

permits a reversible hydraulic motor to be mounted coaxially on the end of the exciter shaft without unacceptably increasing the overall length of a drum assembly, thereby further simplifying the machine's assembly and facilitating maintenance or repair of the machine.

b. Rejection Under § 102(b)

i. Rejection of Claims 1, 5, 9, and 31

Claims 1, 5, 9, and 31 stand rejected under 35 U.S.C. §102(b) as being anticipated by the French '198 patent. The Examiner contends, *inter alia*, that the elements 22, 24 correspond to the claimed free swinging weights, and that the shaded, unlabeled elements between elements 14 and 22 and 16 and 24, respectively, correspond to the claimed exciter assembly components. The Examiner is mistaken.

Referring to the attached Declaration of Gregory J. Orzal, one skilled in the art understands that the structures illustrated in Figures 2 and 4 of the French '198 patent to constitute standard mounting hardware, most probably retaining rings or spacers (Orzal Decl., ¶6). In either event, they comprise standard structures mounted on the exciter shaft to prevent the free swinging weights from moving axially along the shaft. These mounting structures were in universal use at the time that the French '198 patent was filed and were still universally until the development of the invention disclosed and claimed in the present application. (Orzal Decl., ¶4) Because there is nothing in the French '198 patent to cast any doubt at Mr. Orzals' statements, the Examiner is obliged to take it at face value. *In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995).

Hence, those elements comprise standard mounting hardware, which the specification and Mr. Orzal's declaration confirm cannot be considered "an operative component of an exciter assembly."<sup>2</sup> While the Examiner is entitled to construe claimed terms broadly, he is *not* permitted to construe a term to have a definition that is expressly disclaimed by specification and prosecution history: When the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question." *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001).

ii. Rejection of Claims 6 and 8

The rejection of claims 6 and 8 over the French '198 patent in view of Century and Salani or Polacek, respectively, is respectfully traversed because none of the secondary references cure the above-discussed fundamental deficiency of the French '198 patent.

3. Allowable Subject Matter and Conclusions

The indication of the presence of allowable subject matter in claims 10 and 11 is noted with appreciation. Claim 10 has now been rewritten in independent form to

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<sup>2</sup> The term "operative component" was first used in claims 1, 9 and 31 upon the submission of this amendment. However, *ipsis verbis* support for that term can be found, e.g., on page 6, lines 20-23 and page 8, lines 19-23 of the present application. Operative components are distinguished from mounting hardware such as retainer rings, e.g., on, page 3, lines 10-23 and page 8, lines 15-18 of the specification.

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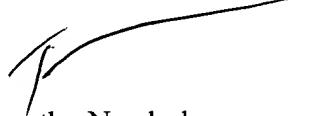
include the limitations of claim 9, thereby placing these claims in *prima facie* condition for allowance.

It is submitted that original claims 1-23 and 25-31 are in compliance with 35 U.S.C. §§ 102 and 103 and each define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

Enclosed is a check in the amount of \$1,020 for a three-month extension of time, which applicant hereby requests. No other fees are believed to be payable with this communication. Nevertheless, should the Examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

The Examiner is invited to contact the undersigned by telephone if it would help expedite matters.

Respectfully submitted,



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Dated: December 21, 2004

Enclosure:

Declaration of Gregory J. Orzal

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